

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : EXPEDITED PROCEDURE
Christian BAUER : RESPONSE UNDER 37 CFR 1.116
U.S. Patent Application No. 10/767,744 :
Filed: January 30, 2004 : Group Art Unit: 3632
For: RETAINING MEMBER : Confirmation No. 5715
Examiner: Alfred J. Wujciak

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

This paper is submitted in reply to the Final Office Action mailed *April 17, 2006*.

Applicants respectfully request review of the final rejections of claims 19-24, 26-29 and 31-41 as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

1. The *35 U.S.C. 112, second paragraph* rejection of claims 39-41 is clearly erroneous and hence, traversed, because the claim scope is clear and ascertainable to a person of ordinary skill in the art.

In the Final Office Action at page 2 the last full paragraph, the Examiner appears to state that the claim feature does not find antecedent basis or support in the application as filed. This issue cannot serve as a basis for rejecting the claims under *35 U.S.C. 112, second paragraph*.

Further, Applicants respectfully submit that the claim feature finds support in at least FIG. 3, which discloses that the connecting elements (V shape in FIG. 3, and 39, 41 in FIG. 2) extend through a thickness of the harder material (arms 9, 10 in FIG. 3). The thickness is defined between the lower surface (near reference numeral 5 in FIG. 3) of each arm 9, 10 and the upper surface of each arm 9, 10 (the curved wall of the harder material in each recess 18-21).

2. The *35 U.S.C. 103(a)* rejection of claims 21-24, 26-29 and 31-33 as being obvious over *Miura* is clearly erroneous and, hence, traversed for the reasons advanced in the Amendment filed March 17, 2005, at page 11 line 10 from bottom through page 12 line 7 from bottom, which are incorporated herein by reference.

In particular, *Miura teaches away* from the one-piece structure of independent claim 21 and is not modifiable to arrive at the claimed invention, notwithstanding the Examiner's alleged "reduced manufacturing cost" argument. The Examiner has failed to follow the USPTO guidance provided in *MPEP*, section 2145 in considering Applicant's rebuttal argument. (It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

3. As to claim 27 and 31, Applicant respectfully submits that the claimed convex lower surface is not an obvious designer's choice, because the claims feature is significant as disclosed in the specification, at the paragraph bridging pages 3-4. *See MPEP*, section 2144.04 IV. B.

In particular, claim 27 finds support in the application as filed which discloses that each of the resilient contact elements (36, 37 in FIGs. 1-2) has a convex lower surface (FIG. 3, at the surface pointed to by reference numeral 5 and page 4, lines 2-3 of the specification) extending from a lowermost point (near the arrow associated with numeral reference 5 in FIG. 3) upwardly in opposite directions towards said arms (9-10). An advantage of the claimed invention is that the contact area is kept as short as possible, improving acoustic isolation. *See* the specification, at the paragraph bridging pages 3-4, especially the first sentence.

In *Miura*, the resilient contact elements, according to the Examiner, are 11b which are adapted to contact the flat surface of support B (FIG. 30 of *Miura*). The Examiner argued that it would have been obvious to have modified the shape of *Miura*'s elements 11b to convex lower surface to maintain the base portion on the support surface. *See* Final Office Action at page 8, lines 1-2. By the Examiner's rationale, the lower surface of *Miura* must be flat to match the flat surface of support B to whereby "maintain the base portion on the support surface." The reference clearly fails to teach or suggest and is not modifiable to include the claimed convex lower surface of the resilient contact elements.

4. As to claims 28-29, Applicant notes that the Examiner has not responded to Applicant's argument advanced in the Amendment filed March 17, 2005, at page 13, the second full paragraph, which is incorporated herein by reference.

In particular, the applied references, especially *Miura*, clearly fail to teach or suggest the claimed annular **downwardly extending** wall positioned **between said resilient contact elements**. The claim limitation finds support in at least FIG. 1 where it is disclosed that annular wall 28 is

positioned between resilient contact elements 11. Wall 28 is downwardly extending as can be seen in FIG. 3 at the step between lowermost surface 5 and the lower surface of 2. In *Miura*, the corresponding element, i.e., the unnumbered, outermost element immediately above 11b in FIG. 30, is not positioned between the legs 11b, contrary to the claimed invention.

5. The 35 U.S.C. 103(a) rejection of claims 19-20, 34-36 and 38-39 as being obvious over *Miura* in view of *Thornton* is clearly erroneous and, hence, traversed for the reasons advanced in the Amendment filed February 3, 2006, at page 9 the last full paragraph through page 10 line 5 from bottom, which are incorporated herein by reference.

In particular, *Thornton* is non-analogous art and cannot be combined with *Miura*.

In addition, *Thornton* teaches, at best, only lining 26 in its recess (18, 24 in FIG. 4). Thus, even if *Thornton* was combinable with *Miura*, which Applicants contend to the contrary, the resulting device would include only the *Thornton* lining 26 on the inner walls of recesses 28a-30a in FIG. 1 of *Miura*. Such lining would not be connected to the *Miura* resilient contact portion 11b (FIG. 1), contrary to the claimed invention. The Examiner's *Miura/Thornton* combined device is not modifiable to include the claim limitation, lacking an adequate suggestion or motivation to do so.

Finally, if the lining which is on element 21 (FIG. 1 of *Miura*) was connected to resilient contact portion 11b which is on element 10 (FIG. 1 of *Miura*), the *Miura* elements 21 and 10 would be connected and such connection would prevent parts 21 and 10 from being easily disconnectable. Therefore, the intended purpose of the *Miura* two-piece configuration would be defeated and the reference being modified, i.e., *Miura*, would be unsatisfactory for its intended purpose of providing a clamp that can be adapted to various diameters of post S (FIG. 30). See e.g., *Miura* at column 1, lines 39-44, column 2, lines 4-5 and column 7, lines 35-45 especially lines 43-44.

Accordingly, claims 19-20, 34-36 and 38-39 are not obvious over *Miura* and *Thornton*.

Withdrawal of the final rejections of claims 19-24, 26-29 and 31-41 in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under *37 C.F.R. 1.136* is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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